Supreme Court, U.S.
FILED
05-397 SEP 21 2005
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No. ___

IN THE

Supreme Court of the United States

1-800 CONTACTS, INC.,
Petitioner,

v.

WHENU.COM, INC.,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit

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PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Does "use" of a trademark under the Lanham Act require that the trademark be displayed or visible to consumers?

PARTIES TO THE PROCEEDING

Pursuant to Rule 14.1(b), the following list identifies all the parties appearing here and before the United States Court of Appeals for the Second Circuit:

The Petitioner here and Appellee below is 1-800 Contacts, Inc.

The Respondent here and Appellant below is WhenU.Com, Inc.

Vision Direct, Inc. was also an Appellant below, but 1-800 Contacts, Inc. and Vision Direct, Inc. filed a stipulation of dismissal with respect to all of 1-800 Contact, Inc.'s claims against Vision Direct, Inc. See Pet. App. 3a, n.6. As a result, Vision Direct, Inc. is not listed as a Respondent with regard to the present petition.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 29.6, Petitioner 1-800 Contacts, Inc. ("Petitioner" or "1-800 Contacts") states that it is a publicly-traded company. Petitioner does not have any parent company and no publicly held company owns 10% or more of Petitioner's stock.

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OPINIONS BELOW

The opinion of the United States Court of Appeals for the Second Circuit ("Second Circuit") is reported at 414 F.3d 400 (2d Cir. 2005), and is reprinted in the Appendix to the Petition ("Pet. App.") at 1a-22a. The opinion of the U.S. District Court for the Southern District of New York ("district court") is reported at 309 F.Supp.2d 467 (S.D.N.Y. 2003), and is reprinted at Pet. App. 23a-95a.

JURISDICTION

The United States Court of Appeals for the Second Circuit entered its judgment on June 27, 2005. This Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

This case involves provisions of Article I, Section 8, Clause 3 of the Constitution of the United States, which grants Congress power over trademarks based on its power to "regulate commerce with foreign nations, among the States and with Native American Tribes."

This case also involves provisions of the Lanham Act, 15 U.S.C. § 1051, *et seq.*, with relevant excerpts appearing below and the full text of the relevant provisions reproduced at Pet. App. 96a-114a.

Section 32 of the Lanham Act, 15 U.S.C. § 1114, provides in pertinent part,

(1) Any person who shall, without the consent of the registrant—

> (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . .

. . . ,

shall be liable in a civil action for the remedies hereinafter provided.

Section 43 of the Lanham Act, 15 U.S.C. § 1125(a), provides in pertinent part,

> (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
>
> > (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
> >
> > (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Section 45 of the Lanham Act, 15 U.S.C. § 1127, provides in pertinent part,

The word "commerce" means all commerce which may lawfully be regulated by Congress.

. . .

The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. [A] mark shall be deemed to be in use in commerce—